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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/019,735	12/28/2001	Katsutoshi Sasaki	5.1196	7344

5514 7590 05/04/2004

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EXAMINER	
PROUTY, REBECCA E	
ART UNIT	PAPER NUMBER
1652	

DATE MAILED: 05/04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/019,735	SASAKI ET AL.	
	Examiner	Art Unit	
	Rebecca E. Prouty	1652	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-44,46,47,50-53 and 55-62* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☐ Claim(s) _____ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☒ Claim(s) *1-44, 46, 47, 50-53, and 55-62* are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

Claims 45, 48, 49, and 54 have been canceled. Claims 1-44, 46, 47, 50-53, and 55-62 are at issue and are present for examination.

Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-3 and 6-12, drawn to a β1,3-N-acetylglucosaminyltransferase of SEQ ID NO:1, classified in class 435, subclass 193.

II. Claims 1-3 and 6-12, drawn to a β1,3-N-acetylglucosaminyltransferase of SEQ ID NO:2, classified in class 435, subclass 193.

III. Claims 1-4 and 8-12, drawn to a β1,3-N-acetylglucosaminyltransferase of SEQ ID NO:3, classified in class 435, subclass 193.

IV. Claims 1-5 and 8-12, drawn to a β1,3-N-acetylglucosaminyltransferase of SEQ ID NO:4, classified in class 435, subclass 193.

V. Claims 13, 22, 25, 26, 29, 30, and 46, drawn to a polynucleotide, vectors or host cells encoding a β1,3-N-acetylglucosaminyltransferase of SEQ ID NO:1 or expression of said polynucleotides, classified in class 536, subclass 23.2.

VI. Claims 13, 18, 22, 25, 26, 29, 30, and 46, drawn to a polynucleotide, vectors or host cells encoding a β1,3-N-acetylglucosaminyltransferase of SEQ ID NO:2 or expression of said polynucleotides, classified in class 536, subclass 23.2.

VII. Claims 13, 14, 16-21, 23-26, 29, 30, and 46, drawn to a polynucleotide, vectors or host cells encoding a β1,3-N-acetylglucosaminyltransferase of SEQ ID NO:3 or expression of said polynucleotides, classified in class 536, subclass 23.2.

VIII Claims 13-26, 29, 30, 41, 42, and 46, drawn to a polynucleotide, vectors or host cells encoding a β1,3-N-acetylglucosaminyltransferase of SEQ ID NO:4 or expression of said polynucleotides, classified in class 536, subclass 23.2.

IX. Claims 27 and 28, drawn to methods of making a β1,3-N-acetylglucosaminyltransferase of SEQ ID NO:1 using a transgenic animal, classified in class 800, subclass 4.

X. Claims 27 and 28, drawn to methods of making a β1,3-N-acetylglucosaminyltransferase of SEQ ID NO:2 using a

transgenic animal, classified in class 800, subclass 4.

XI. Claims 27 and 28, drawn to methods of making a β1,3-N-acetylglucosaminyltransferase of SEQ ID NO:3 using a transgenic animal, classified in class 800, subclass 4.

XII. Claims 27 and 28, drawn to methods of making a β1,3-N-acetylglucosaminyltransferase of SEQ ID NO:4 using a transgenic animal, classified in class 800, subclass 4.

XIII Claims 31-33 and 38, drawn to methods of making a sugar using the β1,3-N-acetylglucosaminyltransferase of SEQ ID NO:1, classified in class 435, subclass 97.

XIV. Claims 31-33 and 38, drawn to methods of making a sugar using the β1,3-N-acetylglucosaminyltransferase of SEQ ID NO:2, classified in class 435, subclass 97.

XV. Claims 31-33 and 38, drawn to methods of making a sugar using the β1,3-N-acetylglucosaminyltransferase of SEQ ID NO:3, classified in class 435, subclass 97.

XVI. Claims 31-33 and 38, drawn to methods of making a sugar using the β1,3-N-acetylglucosaminyltransferase of SEQ ID NO:4, classified in class 435, subclass 97.

XVII Claims 34-35, drawn to methods of making a sugar using a transformed cell encoding a β1,3-N-acetylglucosaminyltransferase of SEQ ID NO:1, classified in class 435, subclass 97.

XVIII. Claims 34-35, drawn to methods of making a sugar using a transformed cell encoding a β1,3-N-acetylglucosaminyltransferase of SEQ ID NO:2, classified in class 435, subclass 97.

XIX. Claims 34-35, drawn to methods of making a sugar using a transformed cell encoding a β1,3-N-acetylglucosaminyltransferase of SEQ ID NO:3, classified in class 435, subclass 97.

XX. Claims 34-35, drawn to methods of making a sugar using a transformed cell encoding a β1,3-N-acetylglucosaminyltransferase of SEQ ID NO:4, classified in class 435, subclass 97.

XXI. Claims 36 and 39, drawn to methods of making a sugar using a transgenic animal producing a β1,3-N-acetylglucosaminyltransferase of SEQ ID NO:1, classified in class 800, subclass 13.

XXII. Claims 36 and 39, drawn to methods of making a sugar using a transgenic animal producing a β1,3-N-

acetylglucosaminyltransferase of SEQ ID NO:2, classified in class 800, subclass 13.

XXIII. Claims 36 and 39, drawn to methods of making a sugar using a transgenic animal producing a β1,3-N-acetylglucosaminyltransferase of SEQ ID NO:3, classified in class 800, subclass 13.

XXIV. Claims 36 and 39, drawn to methods of making a sugar using a transgenic animal producing a β1,3-N-acetylglucosaminyltransferase of SEQ ID NO:4, classified in class 800, subclass 13.

XXV. Claim 37, drawn to methods of making a sugar using a transgenic plant producing a β1,3-N-acetylglucosaminyltransferase of SEQ ID NO:1, classified in class 800, subclass 295.

XXVI. Claim 37, drawn to methods of making a sugar using a transgenic plant producing a β1,3-N-acetylglucosaminyltransferase of SEQ ID NO:2, classified in class 800, subclass 295.

XXVII. Claim 37, drawn to methods of making a sugar using a transgenic plant producing a β1,3-N-acetylglucosaminyltransferase of SEQ ID NO:3, classified in class 800, subclass 295.

XXVIII. Claim 37, drawn to methods of making a sugar using a transgenic plant producing a β1,3-N-acetylglucosaminyltransferase of SEQ ID NO:4, classified in class 800, subclass 295.

XXIX. Claims 40 and 44 drawn to a methods of determining the expression level of a polynucleotide encoding a β1,3-N-acetylglucosaminyltransferase of SEQ ID NO:1 by hybridization, classified in class 435, subclass 6.

XXX. Claims 40 and 44 drawn to a methods of determining the expression level of a polynucleotide encoding a β1,3-N-acetylglucosaminyltransferase of SEQ ID NO:2 by hybridization, classified in class 435, subclass 6.

XXXI. Claims 40 and 44 drawn to a methods of determining the expression level of a polynucleotide encoding a β1,3-N-acetylglucosaminyltransferase of SEQ ID NO:3 by hybridization, classified in class 435, subclass 6.

XXXII. Claims 40 and 44 drawn to a methods of determining the expression level of a polynucleotide encoding a β1,3-N-acetylglucosaminyltransferase of SEQ ID NO:4 by hybridization, classified in class 435, subclass 6.

XXXIII. Claim 43 drawn to a methods of determining the expression level of a polynucleotide encoding a β1,3-N-

acetylglucosaminyltransferase of SEQ ID NO:1 by PCR, classified in class 435, subclass 6.

XXXIV. Claim 43 drawn to a methods of determining the expression level of a polynucleotide encoding a β1,3-N-acetylglucosaminyltransferase of SEQ ID NO:2 by PCR, classified in class 435, subclass 6.

XXXV. Claim 43 drawn to a methods of determining the expression level of a polynucleotide encoding a β1,3-N-acetylglucosaminyltransferase of SEQ ID NO:3 by PCR, classified in class 435, subclass 6.

XXXVI. Claim 43 drawn to a methods of determining the expression level of a polynucleotide encoding a β1,3-N-acetylglucosaminyltransferase of SEQ ID NO:4 by PCR, classified in class 435, subclass 6.

XXXVII. Claims 47, 50, and 51, drawn to an antibody to the β1,3-N-acetylglucosaminyltransferase of SEQ ID NO:1, classified in class 530, subclass 387.9.

XXXVIII. Claims 47, 50, and 51, drawn to an antibody to the β1,3-N-acetylglucosaminyltransferase of SEQ ID NO:2, classified in class 530, subclass 387.9.

XXXIX. Claims 47, 50, and 51, drawn to an antibody to the β1,3-N-acetylglucosaminyltransferase of SEQ ID NO:3, classified in class 530, subclass 387.9.

XL. Claims 47, 50, and 51, drawn to an antibody to the β1,3-N-acetylglucosaminyltransferase of SEQ ID NO:4, classified in class 530, subclass 387.9.

XLI. Claim 52, drawn to a methods for screening for modulators of a β1,3-N-acetylglucosaminyltransferase of SEQ ID NO:1, classified in class 435, subclass 15.

XLII. Claim 52, drawn to a methods for screening for modulators of a β1,3-N-acetylglucosaminyltransferase of SEQ ID NO:2, classified in class 435, subclass 15.

XLIII. Claim 52, drawn to a methods for screening for modulators of a β1,3-N-acetylglucosaminyltransferase of SEQ ID NO:3, classified in class 435, subclass 15.

XLIV. Claim 52, drawn to a methods for screening for modulators of a β1,3-N-acetylglucosaminyltransferase of SEQ ID NO:4, classified in class 435, subclass 15.

XLV. Claim 53, drawn to a methods for screening for modulators of the expression of a gene encoding the

β1,3-N-acetylglucosaminyltransferase of SEQ ID NO:1, classified in class 435, subclass 6.

XLVI. Claim 53, drawn to a methods for screening for modulators of the expression of a gene encoding the β1,3-N-acetylglucosaminyltransferase of SEQ ID NO:2, classified in class 435, subclass 6.

XLVII. Claim 53, drawn to a methods for screening for modulators of the expression of a gene encoding the β1,3-N-acetylglucosaminyltransferase of SEQ ID NO:3, classified in class 435, subclass 6.

XLVIII. Claim 53, drawn to a methods for screening for modulators of the expression of a gene encoding the β1,3-N-acetylglucosaminyltransferase of SEQ ID NO:4, classified in class 435, subclass 6.

IL. Claims 55-57, drawn to a promoter capable of controlling transcription of a β1,3-N-acetylglucosaminyltransferase gene, classified in class 536, subclass 24.1.

L. Claims 58 and 59, drawn to methods of screening for modulators of a promoter capable of controlling transcription of a β1,3-N-acetylglucosaminyltransferase gene, classified in class 435, subclass 6.

LI. Claim 60, drawn to a modulator of the β1,3-N-acetylglucosaminyltransferase of SEQ ID NO:1, classification unknown as the structure of the modulator is completely undefined.

LII. Claim 60, drawn to a modulator of the β1,3-N-acetylglucosaminyltransferase of SEQ ID NO:2, classification unknown as the structure of the modulator is completely undefined.

LIII. Claim 60, drawn to a modulator of the β1,3-N-acetylglucosaminyltransferase of SEQ ID NO:3, classification unknown as the structure of the modulator is completely undefined.

LIV. Claim 60, drawn to a modulator of the β1,3-N-acetylglucosaminyltransferase of SEQ ID NO:4, classification unknown as the structure of the modulator is completely undefined.

LV. Claims 61 and 62, drawn to an animal in which the gene encoding the β1,3-N-acetylglucosaminyltransferase of SEQ ID NO:1 has been deleted or mutated, classified in class 800, subclass 8.

LVI. Claims 61 and 62, drawn to an animal in which the gene encoding the β1,3-N-acetylglucosaminyltransferase of

SEQ ID NO:2 has been deleted or mutated, classified in class 800, subclass 8.

LVII. Claims 61 and 62, drawn to an animal in which the gene encoding the β1,3-N-acetylglucosaminyltransferase of SEQ ID NO:3 has been deleted or mutated, classified in class 800, subclass 8.

LVIII. Claims 61 and 62, drawn to an animal in which the gene encoding the β1,3-N-acetylglucosaminyltransferase of SEQ ID NO:4 has been deleted or mutated, classified in class 800, subclass 8.

The inventions are distinct, each from the other because of the following reasons:

The proteins of Groups I-IV, the DNAs of Groups V-III and IL, the antibodies of Groups XXXVII-XL, the modulators of Groups LI-LIV, and the knockout animals of Groups LV-LVIII, each comprise a chemically unrelated structure capable of separate manufacture, use and effect. The DNAs comprise a nucleic acid sequence, the proteins of Groups I-IV and XXXVII-XL each comprise an unrelated amino acid sequence, and the modulators comprise a completely unknown chemical structure. The DNAs have other utility besides encoding the proteins of Groups I-IV such as a hybridization probe and the proteins can be made by another

method such as isolation from natural sources or chemical synthesis. Inventions I-IV, V-VIII, XXXVII-XL, LI-LIV, and LV-LVIII are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions have different effects as they constitute structurally different polypeptides, the polynucleotides encoding them, unknown chemical compounds or animals with distinct genetic components. Therefore, where structural identity is required, such as for hybridization or expression, or antibody/antigen reactivity the different sequences have different effects.

Inventions I and XIII or XLI are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the β1,3-N-acetylglucosaminyltransferase of SEQ ID NO:1 can be used to induce the antibodies of Group XXXVII.

The DNAs of Groups V-VIII, the polypeptides of Groups II-IV, the antibodies of Groups XXXVII-XL, the promoter of Group IL, the modulators of Groups LI-LIV and the knockout animals of Groups LV-LVIII are distinct from the methods of Groups XIII or XLI, as these products are neither made nor used by the methods of Groups XIII or XLI.

Inventions II and XIV or XLII are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the β1,3-N-acetylglucosaminyltransferase of SEQ ID NO:2 can be used to induce the antibodies of Group XXXVIII.

The DNAs of Groups V-VIII, the polypeptides of Groups I, III, and IV, the antibodies of Groups XXXVII-XL, the promoter of Group IL, the modulators of Groups LI-LIV and the knockout animals of Groups LV-LVIII are distinct from the methods of Groups XIV or XLII, as these products are neither made nor used by the methods of Groups XIV or XLII.

Inventions III and XV or XLIII are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the β1,3-N-acetylglucosaminyltransferase of SEQ ID NO:3 can be used to induce the antibodies of Group XXXIX.

The DNAs of Groups V-VIII, the polypeptides of Groups I, II, and IV, the antibodies of Groups XXXVII-XL, the promoter of Group IL, the modulators of Groups LI-LIV and the knockout animals of Groups LV-LVIII are distinct from the methods of Groups XV or XLIII, as these products are neither made nor used by the methods of Groups XV or XLIII.

Inventions IV and XVI or XLIV are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the β1,3-N-

acetylglucosaminyltransferase of SEQ ID NO:4 can be used to induce the antibodies of Group XL.

The DNAs of Groups V-VIII, the polypeptides of Groups I-III, the antibodies of Groups XXXVII-XL, the promoter of Group IL, the modulators of Groups LI-LIV and the knockout animals of Groups LV-LVIII are distinct from the methods of Groups XVI or XLIV, as these products are neither made nor used by the methods of Groups XVI or XLIV.

Inventions V and IX, XVII, XXI, XXV, XXIX, XXXIII or XLV are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the gene encoding the β1,3-N-acetylglucosaminyltransferase of SEQ ID NO:1 can be used to produce the protein of Group I.

The polypeptides of Groups I-IV, the DNAs of Groups VI-VIII, the antibodies of Groups XXXVII-XL, the promoter of Group IL, the modulators of Groups LI-LIV and the knockout animals of Groups LV-LVIII are distinct from the methods of Groups IX, XVII, XXI, XV, XXIX, XXXIII or XLV, as these products are

neither made nor used by the methods of Groups IX, XVII, XXI, XV, XXIX, XXXIII or XLV.

Inventions VI and X, XVIII, XXII, XXVI, XXX, XXXIV or XLVI are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the gene encoding the β1,3-N-acetylglucosaminyltransferase of SEQ ID NO:2 can be used to produce the protein of Group II.

The polypeptides of Groups I-IV, the DNAs of Groups V, VII, and VIII, the antibodies of Groups XXXVII-XL, the promoter of Group IL, the modulators of Groups LI-LIV and the knockout animals of Groups LV-LVIII are distinct from the methods of Groups X, XVIII, XXII, XXVI, XXX, XXXIV or XLVI, as these products are neither made nor used by the methods of Groups X, XVIII, XXII, XXVI, XXX, XXXIV or XLVI.

Inventions VII and XI, XIX, XXIII, XXVII, XXXI, XXXV or XLVII are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed

can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the gene encoding the β1,3-N-acetylglucosaminyltransferase of SEQ ID NO:3 can be used to produce the protein of Group III.

The polypeptides of Groups I-IV, the DNAs of Groups V, VI, and VIII, the antibodies of Groups XXXVII-XL, the promoter of Group IL, the modulators of Groups LI-LIV and the knockout animals of Groups LV-LVIII are distinct from the methods of Groups XI, XIX, XXIII, XXVII, XXXI, XXXV or XLVII, as these products are neither made nor used by the methods of Groups XI, XIX, XXIII, XXVII, XXXI, XXXV or XLVII.

Inventions VIII and XII, XX, XXIV, XXVIII, XXXII, XXXVI or XLVIII are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the gene encoding the β1,3-N-acetylglucosaminyltransferase of SEQ ID NO:4 can be used to produce the protein of Group IV.

The polypeptides of Groups I-IV, the DNAs of Groups V-VII, the antibodies of Groups XXXVII-XL, the promoter of Group IL, the modulators of Groups LI-LIV and the knockout animals of Groups LV-LVIII are distinct from the methods of Groups XII, XX, XXIV, XXVIII, XXXII, XXXVI or XLVIII, as these products are neither made nor used by the methods of Groups XII, XX, XXIV, XXVIII, XXXII, XXXVI or XLVIII.

Inventions IL and L are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the promoter of group IL can be transcribing a genes.

The polypeptides of Groups I-IV, the DNAs of Groups V-VIII, the antibodies of Groups XXXVII-XL, the modulators of Groups LI-LIV and the knockout animals of Groups LV-LVIII are distinct from the method of Groups L, as these products are neither made nor used by the method of Groups L.

The methods of Groups IX-XXXVI, XLI-XLVIII, and L are independent as they comprise different steps, utilize different products and produce different results.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter as shown by their different classification, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and a product claim is subsequently found allowable, withdrawn process claims that depend from or otherwise include all the limitations of the allowable product claim will be rejoined in accordance with the provisions of MPEP § 821.04. **Process claims that depend from or otherwise include all the limitations of the patentable product** will be entered as a matter of right if the amendment is presented prior to final rejection or allowance, whichever is earlier. Amendments

submitted after final rejection are governed by 37 CFR 1.116; amendments submitted after allowance are governed by 37 CFR 1.312.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103, and 112. Until an elected product claim is found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowed product claim will not be rejoined. See "Guidance on Treatment of Product and Process Claims in light of *In re Ochiai, In re Brouwer* and 35 U.S.C. § 103(b)," 1184 O.G. 86 (March 26, 1996). Additionally, in order to retain the right to rejoinder in accordance with the above policy, Applicant is advised that the process claims should be amended during prosecution either to maintain dependency on the product claims

or to otherwise include the limitations of the product claims. **Failure to do so may result in a loss of the right to rejoinder.**

Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rebecca Prouty, Ph.D. whose telephone number is (571) 272-0937. The examiner can normally be reached on Monday-Friday from 8:30 to 4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ponnathapura Achutamurthy, can be reached at (571) 272-0928. The fax phone number for this Group is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (571) 272-1600.

REBECCA E. PROUTY
PRIMARY EXAMINER
GROUP ~~1800~~ 1600